

REMARKS

Status of the Claims

In his October 20, 2004 Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims. Examiner rejected claims 1, 7, 8, 9, 10, 13, and 16 under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement. Examiner rejected claims 1, 4, 5, and 21 under 35 U.S.C. § 112 ¶ 2 as being indefinite or failing to point out and distinctly claim the subject matter which Applicant views as the invention. Finally, Examiner rejected claims 1 – 24 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,791,707 to Laverty et al. in view of the ImageX.com SEC filing of May 12, 1999.

Applicant has amended claims 1, 7, 8, 9, 10, 11, 13, and 16 to remove references to “order processing interface” and “profile management interface.” This amendment is not intended to change the scope of the claims.

Objection to the Drawings

The Examiner has objected to the drawings because they fail to show two specific elements of the claims: the order processing interface and the profile management interface.

Applicant has amended the claims to eliminate the references to “order processing interface” and “profile management interface.” This amendment in no way limits the scope of the Applicant’s claims.

Applicant respectfully requests that the Examiner remove the objections to the drawings.

Section 112 ¶ 1 rejection

The Examiner rejects claims 1, 7, 8, 9, 10, 13, and 16 under 35 U.S.C. § 112 ¶ 1 because the terms order processing interface and profile management interface are not adequately described in the specification.

As stated above, the Applicant has amended the claims to eliminate references to “order processing interface” and “profile management interface.”

Section 112 ¶ 2 rejection

The Examiner rejects claims 4 under 35 U.S.C. § 112 ¶ 2 because the claim treats title as user-indicative information. Examiner asserts that the description treats title as company-indicative information on page 4, line 18 through page 5, line 2.

Applicant respectfully points out that “title” is not mentioned in the description on page 4, line 18 through page 5, line 2. Furthermore, “title” is not defined as being company-indicative anywhere in the written description or drawings. The written description does assert that a “title” may be considered company-indicative information. (Specification, p. 10, line 21-24 [emphasis added]). However, it need not necessarily be considered company-indicative. It is common knowledge that many companies allow a great deal of flexibility in an employee’s selection of titles, particularly for use on business cards and other materials used predominantly for marketing and sales purposes. Finally, the discussion of user-indicative on page 4, line 18 through page 5, line 2 states that “profile comprises user-indicative information such as name and address . . .” The use of the terms “comprises” and “such as” indicate that this list is not meant to be inclusive; therefore, the failure to include “title” in this list does not mean that “title” can not be user-indicative information.

The Examiner rejects claims 1, 5, and 21 under 35 U.S.C. §112 ¶ 2 because the claims and written descriptions disagree as to whether or not a user can modify company-indicative information.

The Applicant respectfully asserts that the claims are not in conflict with the description, nor are they in conflict with one another. First, claim 1 states that the use may not “modify the typography of any information to be printed on the business card.” Typography generally refers to placement and sizing of the information to be printed. Company-indicative information refers to the underlying data that is to be printed, not the typography.

Secondly, claims 5 refers to a user’s inability to modify “at least a portion” of the company-indicative information, while the descriptions of Figures 6 and 7 also refer to the user’s ability to modify “at least a portion” of the company-indicative data. These “portions” are subsets of the whole, they need not refer to the same subsets, and the memberships of those subsets can be completely independent from one another. Therefore, these assertions are not necessarily in conflict with one another. Furthermore, depending on the needs of the client-company using the Applicant’s invention, the client company can choose to allow its employees to alter all, some or none of the company-indicative information when the employee places his order. Which information may be altered by the employee may vary widely from customer to customer. Therefore, the use of the term “at least a portion” accurately defines the permissible customization of the system.

Thirdly, the Examiner assumed that the term “organization-identifying information” in claim 21 was synonymous with “company-indicative information.” Whereas company-indicative information has been established in the written description to possibly include items such as authorized titles and addresses of different offices of the organization, these items do not identify the organization as a whole. Organization-identifying information would be limited by common knowledge to include only items such as company name, a logo, or possibly a company website address which are necessarily uniform across the entire organization. Therefore, claim 21 is not indefinite under 35 U.S.C. § 112 ¶ 2.

Applicant respectfully requests that the section 112 rejections be withdrawn.

Section 103 rejection

The Examiner rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over Laverty et al., U.S. Patent No. 6,791,707 (entitled "Automated, Hosted Prepress Applications") in view of ImageX.com SEC Filing of May 12th, 1999.

Laverty et al. was filed on December 3, 2001. It purports to be a continuation of application No. 09/480,866, filed on January 10, 2000.

This application was filed on January 18, 2000. But the invention was long in the making. Applicant conceived and reduced to practice the entire invention as claimed prior to January 10, 2000, as attested to by the attached 37 C.F.R. § 1.131 affidavit.

The Applicant submits further evidence to corroborate his testaments in the aforementioned affidavit. To establish an actual reduction to practice requires a showing that the process actually worked for its intended purpose. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). The inventor must show independent corroborating evidence in addition to his or her own documents, such as testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Markman v. Lehman, 987 F. Supp. 25, 30 (D.D.C. 1997).

Under these guidelines, the Applicant is also submitting for consideration by the Examiner an affidavit from a client of the Applicant. This client attests that the documents attached as Exhibits to the aforementioned 1.131 affidavit result from a series of transactions that occurred during the months of June through October of 1999. This affidavit further asserts that during this timeframe, the attestee's company made use of the Applicant's invention to provide printed business cards.

Because the Laverty et al. reference does not constitute prior art, Applicant respectfully requests that the claims be allowed and passed to issue.

Appl. No. 09/487387
Response dated April 20, 2005
Reply to Office Action of October 20, 2005

CONCLUSION

Having addressed all matters raised by the Examiner's October 20, 2004 Office Action, Applicant respectfully requests that the claims be allowed.

Respectfully submitted,

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Charles W. Hanor
Registration No. 27,132
Phone (210) 558-9500
Fax: (210) 558-9509
e-mail: chanor@hanor.com

ATTORNEY FOR APPLICANT